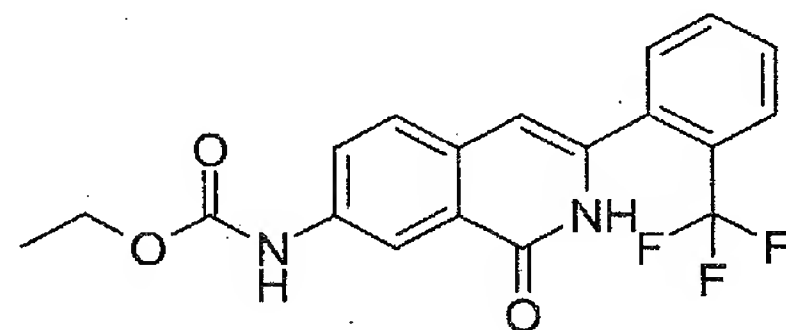


REMARKS

In response to the Restriction Requirement set forth in item 2 on page 2 of the Office Action, Applicants hereby provisionally elect with traverse the invention of Group I, claims 1-21, drawn to a chemical composition, a pharmaceutical composition, and a process for preparing a chemical compound of formula (I).

In response to the Election of Species Requirement set forth in item 4 on page 2, Applicants hereby provisionally elect, with traverse, the following species corresponding to the compound in Example 61 in paragraphs [0361] to [0362] on page 129, which is represented by the following formula:



It is respectfully submitted that at least claims 1-3, 7-10, and 13-18 are readable on the elected species.

The reasons for traverse are as follows.

The requirement is improper as a matter of law. This application is a §371 National Stage application of International Application PCT/JP2005/001764. As such, the Office is required to follow the rules regarding unity of invention in PCT rules 13.1 and 13.2. However, the Office has not done so. Indeed, the Examiner has given no proper reason

why there is lack of unity of invention under the applicable PCT Rules 13.1 and 13.2. Instead, it appears that the Examiner attempts to improperly apply U.S. restriction practice for this application and not the PCT rules for unity of invention. See, Caterpillar Tractor v. Commissioner of Patents and Trademarks, 650 F. Supp. 218 (E.D. Va 1986); and M.P.E.P. § 1850.

Further, it should be noted that a determination of the lack of unity is possible only when the claims of different groups lack a "special technical feature" relative to one another. This is not the case here. Yet, in item 3 on page 2 of the Office Action, the Examiner argues that:

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: a common structure is not present in which the utility is attributed.
[Emphasis added.]

Applicants disagree. In contrast to the Examiner's position, claim 1, which is the main independent claim, covers the compound of formula (I). The remaining claims depend on claim 1 and the recited compound of formula (I). Thus, the compound of formula (I) is believed to be the common structure (i.e., special technical feature) present throughout the claims. Therefore, it is believed that the claims by definition share the same special technical feature of claim 1.

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In other words, the inventions of Groups II and III are so closely linked with that of Group I as to form a single general inventive concept, since the inventions of Groups II and III include the compound recited in claim 1, as an indispensable component. For this reason, the claims are believed to have unity of invention.

In addition, the Examiner's attention is directed to PCT Rule 13.2 in Part 1b of the Annex B of the administrative instructions under the PCT, which specify that "special technical features" is defined as meaning those features that define the contribution which each of the inventions, considered as a whole, makes over the prior art. In other words, PCT Rule 13.2 is art-based and requires the citation of a publication showing the "special technical feature". Therefore, absent any showing that the "special technical feature" shared by all the pending claims is present in a prior art reference, no determination of lack of unity can properly be made. As the Office fails to provide such a citation, Applicants believe that the lack of unity requirement would not be applicable here.

For the these reasons, the Office Action fails to satisfy its burden in showing that the claims lack of unity of invention under the requirements of PCT Rules 13.1 and 13.2.

Further, it is respectfully submitted that had unity of invention been properly applied, unity would have been found to exist and all of the claims would have been examined together in this application. Again, the claims all share the common structure of the compound of formula (I).

Further, in item 5 on page 3, the Examiner argues that restriction is proper, because "the inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required." This argument and the reasons given in support thereof all relate to US restriction practice, and not to requirements for unity of invention.

Nonetheless, even if US Restriction practice were to apply (which it does not), it is believed that restriction in this case would have been improper. It is well established that there are two criteria for a proper requirement for restriction: (1) the inventions must be independent (see M.P.E.P §§ 802.01, 806.06, and 808.01) or distinct as claimed (see M.P.E.P §§ 806.05 to 806.05(j)); and (2) there would be a serious burden on the examiner if restriction is not required (see M.P.E.P. §§ 803.02, 808, and 808.02). It is believed that the claims do not meet these criteria, because the claims

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of the different groups contain overlapping and related subject matter (i.e., compound of formula (I)) that is generic to all of the claims, as discussed above. Again, the claims of the different groups all depend on claim 1 and the recited compound of formula (I). Consequently, a search of the invention of one group would necessarily overlap that of the other groups. Thus, it is believed that a search of all the claims in their entire scope will not constitute a serious burden on the Office given their related and overlapping subject matter.

For these reasons, Applicants submit that the Office's request for restriction is improper. Thus, kindly search and examine of all the claims in their full scope together in this application as the inventions of the different groups have unity of invention.

Further, the requirement is traversed on the basis of the second paragraph of MPEP 803. Applicant respectfully submits that the species are sufficiently similar so that it would not constitute a serious burden to search and examine all three species in the present application, even if those species are patentably distinct (*prima facie* non-obvious) from one another.

In the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider

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the possibility of rejoinder of the non-elected invention,
upon a determination of allowance of the elected invention,
per U.S. rejoinder practice (See M.P.E.P. § 821.04).

It is again noted that claims 22 and 23 depend,
either directly or indirectly, on elected independent claim 1.
Thus, if elected claim 1 is ultimately allowed, its dependent
claims should also be allowed.


Favorable action on the merits is solicited.

If the Examiner has any comments or proposals for
expediting prosecution, please contact the undersigned
attorney at the telephone number below.

Respectfully submitted,

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